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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,416	08/23/2001	David Bruce Kumhyr	AUS920010554US1	9853
35525	7590	04/28/2005	EXAMINER	
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			CHAI, LONGBIT	
			ART UNIT	PAPER NUMBER
			2131	

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,416

Applicant(s)

KUMHYR, DAVID BRUCE

Examiner

Longbit Chai

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 – 32 have been presented for examination. Claims 1, 9, 17, 25 have been amended; and new claims 33 and 34 have been added in an amendment filed 3/7/2005.

Response to Arguments

2. Applicant's arguments filed on 3/7/2005 with respect to the subject matter of the instant claims have been fully considered but are not persuasive.

3. As per claim 1, Applicant remarks that Guski does not show the limitation of "translating said preferred word to produce a password (Page 11, 4th Paragraph)." Examiner notes the argument has been fully considered but is not persuasive. The preferred word is interpreted as the "USER ID" and Guski teaches translating said preferred word USER ID) to produce a password (Guski: see for example, Figure 4 – Password Generation, Element 302 / Element 310).

4. As per claim 9, 17 and 25, Applicant remarks that Guski does not show the limitation of "receiving input specifying a password format (Page 13, 3rd Paragraph)." Examiner notes that the password format is interpreted as 8-characters which is used in the user's host application sign-on request as taught by Guski (Guski: see for example, Figure 4 Element 424 / 310 and Column 9 Line 15 – 17 & Column 11 Line 41 – 45).

5. As per claims 5, 13, 21 and 29, Applicant remarks that Guski does not show or suggest "wherein said password is similar to said preferred word". Examiner notes that "similar to" can be interpreted as anything to some extents that are not identical – for example, both of the preferred word (i.e. USER ID) and one-time password are 64-bits

Art Unit: 2131

(or 8-bytes or 8-characters format) (Guski: see for example, Figure 4 Element 302 / Element 424) and thereby both are similar with respect to the format size. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

6. For existing instant claims, Applicant further argues: "Guski actually teach away from the presented claimed invention because it teaches using rapidly changing dissimilar passwords generated independently of an application". Examiner notes Applicant's argument has no merit since the alleged limitation has not been incorporated into the claim.

7. Regarding claims 1-3, 5, 6, 9-11, 13, 14, 17-19, 21, 22, 25-27, 29 and 30, Applicant remarks that the examiner has failed to state prima facie obviousness rejection. Examiner notes Claims 1-3, 5, 6, 9-11, 13, 14, 17-19, 21, 22, 25-27, 29 and 30 are rejected under 35 U.S.C. 102(b) as anticipated by Guski.

8. As per claim 7, 15, 23 and 31, Applicant argues Examiner has not provided a motivation to combine the references. Examiner disagrees. Sufficient motivation is provided to combine the references – Please see the same reasons set forth in the following Office action.

9. As per claim 8, 16, 24 and 32, Applicant argues Examiner has not provided a motivation to combine the references. Examiner disagrees. Sufficient motivation is provided to combine the references – Please see the same reasons set forth in the following Office action.

Art Unit: 2131

10. Claims 5, 13, 31 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant remarks: "Claims 5, 13, 31 and 29 are definite because the scope of the term 'similar to' while broad, is definite and ascertainable" and Applicant accurately describes the nature of the term "similar to" vis-à-vis the claims in the specification. Examiner notes the 112-second paragraph rejections to claim 5, 13, 31 and 29 are withdrawn after the reconsideration of the arguments.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraph of 35 U.S.C. 102 that forms the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1 – 3, 5, 6, 9 – 11, 13, 14, 17 – 19, 21, 22, 25 – 27, 29 – 30 and 33 – 34 are rejected under 35 U.S.C. 102(b) as anticipated by Guski (Patent Number: 5592553).

As per claim 1, 9, 17 and 25, Guski teaches a method of generating a password, said method comprising:

receiving input from said user, specifying a password format (Guski: see for example, Figure 4 Element 424 / 310 and Column 9 Line 15 – 17 & Column 11 Line 41 – 45: 8-bytes or 8-characters format);

Art Unit: 2131

receiving a preferred word from a user (Guski: see for example, Abstract Line 1 – 13 and Column 3 Line 57 – 60: Guski teaches the non-time-dependent information that ultimately generates the desired password is preferably derived from the information such as a user ID or application ID (Examiner notes “preferably” – could also be something else as user preferred), which is qualified to serve as a simple / preferred word);

translating said preferred word to produce a password; and providing said password to an application (Guski: see for example, Figure 4 – Password Generation, Element 302 / Element 310, Column 11 Line 1 & Table 1 and Column 3 Line 18 – 36: The application is the target application as taught by Guski);

wherein said preferred word is not stored (Guski: see for example, Figure 3 Element 320: The preferred word is transported over to the server at each time of password validation process);

said password is not stored (Guski: see for example, Column 3 Line 18 – 36 & Figure 3: One-time password is time-dependent and is not stored at the user/client side); and

said password complies with said application's required password format (Guski: see for example, Column 9 Line 49 – 50: A legal password should evidently comply with the password format).

As per claim 2, 10, 18 and 26, Guski teaches the claimed invention as described above (see claim 1, 9, 17 and 25 respectively). Guski teaches said translating includes encrypting said preferred word (Guski: see for example, Column 3 Line 57 – 60).

As per claim 3, 11, 19 and 27, Guski teaches the claimed invention as described above (see claim 1, 9, 17 and 25 respectively). Guski teaches said translating includes substituting a character for another character (Guski: see for example, Column 11 Line 1 & Table 1).

As per claim 5, 13, 21 and 29, Guski teaches the claimed invention as described above (see claim 1, 9, 17 and 25 respectively). Guski teaches wherein said password is similar to said preferred word (Guski: see for example, Figure 4 Element 302 / Element 424: Examiner notes that “similar to” can be interpreted as anything to some extents that are not identical – for example, both of the preferred word (i.e. USER ID) and one-time password are 64-bits (or 8-bytes or 8-characters) (Guski: see for example, Figure 4 Element 302 / Element 424) and thereby both are similar with respect to the format size).

As per claim 6, 14, 22 and 30, Guski teaches the claimed invention as described above (see claim 1, 9, 17 and 25 respectively). Guski teaches said translating is accomplished by software running on a first computer; and said target application runs on a second computer (Guski: see for example, Column 7 Line 4 – 7 and Figure 2).

As per claim 33 and 34, Guski teaches the claimed invention as described above (see claim 1 and 9 respectively). Guski further teaches a particular preferred word creates the same password each time the preferred word is translated (Guski: see for example, Figure 4 Element 302 and Element 410: Guski indeed discloses a particular preferred word (i.e. USER ID) creates the same non-time-dependent password (Element 410) after the DES encryption – each time the preferred word is translated from USER ID in conjunction with Application ID and Sign-on key after XOR and DES encryptions / translations into a 64-bit (or 8-byte / 8-characters format)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 4, 7 – 8, 12, 15 – 16, 20, 23 – 24, 28 and 31 – 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guski (Patent Number: 5592553), in view of Audebert (Patent Number: 5887065).

As per claim 7, 15, 23 and 31, Guski teaches the claimed invention as described above (see claim 1, 9, 17 and 25 respectively). Guski does not disclose expressly said translating is accomplished at least in part by a smart card.

Audebert teaches said translating is accomplished at least in part by a smart card (Audebert: see for example, Figure 9 and Column 17 Line 13 – 19).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Audebert within the system of Guski because (a) Guski teaches a password generating / translating method through the use of non-time dependent / non-secret information (Guski: see for example, Column 3 Line 57 – 62) and (b) Audebert teaches a method that most of the translating / converting functions involved in the generation of the password can be implemented into the smart card (Audebert: see for example, Column 17 Line 17 – 19) so that the software implementation on the PC can be simplified (Audebert: see for example, Column 17 Line 13 – 15).

As per claim 4, 12, 20 and 28, Guski teaches the claimed invention as described above (see claim 1, 9, 17 and 25 respectively). Guski does not disclose expressly said translating includes inserting at least one special character.

Audebert teaches said translating includes inserting at least one special character (Audebert: see for example, Abstract Line 13 – 14: Audebert teaches adding the digits to the generated password). See the same rationale of combination applied herein as above in rejecting claim 7.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify adding the digits to the generated password to accommodate adding the special characters to the generated password because password format rule that requires special characters is well-known in the art (Audebert: see for example, Abstract Line 13 – 14).

As per claim 8, 16, 24 and 32, Guski teaches the claimed invention as described above (see claim 1, 9, 17 and 25 respectively). Guski does not disclose expressly said translating is accomplished by software running on the same computer as said target application.

Audebert teaches said translating is accomplished by software running on the same computer as said target application Audebert: see for example, Abstract, the Last two sentences and Column 17 Line 13 – 19: Examiner notes “smart card” is considered as part of the computer integrated / closed entity and thereby, translating / generating a password on a smart card through the use of non-time dependent / non-secret information is indeed translating accomplished by software running on “the same” computer as said target application – i.e. target application residing on the same computer (i.e. PC)).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Audebert within the system of Guski because (a) Guski teaches a password generating / translating method through the use of non-time dependent / non-secret information (Guski: see for example, Column 3 Line

Art Unit: 2131

57 – 62) and (b) Audebert teaches a method that most of (or part of) the translating / converting functions involved in the generation of the password can be implemented into the smart card (Audebert: see for example, Column 17 Line 17 – 19) so that the software implementation on the PC can be simplified (Audebert: see for example, Column 17 Line 13 – 15) – Moreover, Audebert further teaches the concept of “virtual token” (i.e. virtual smart-card) where the time-dependent variables can be generated outside the smart card (i.e. by the PC) while the non-time dependent information (such as static-key) is stored on the smart card that it can offer the advantages without using the permanent power supply in the card while still further simplification, the key can be static (Audebert: see for example, Column 17 Line 53 – 60) and the software implementation on the PC can also be simplified (Audebert: see for example, Column 17 Line 13 – 15) due to offload some tasks to the smart card.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 2131

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Longbit Chai whose telephone number is 571-272-3788. The examiner can normally be reached on Monday-Friday 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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